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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/735,697 12/12/00 LEE

N P1230

EXAMINER
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ART UNIT.	PAPER NUMBER

2836  
DATE MAILED:

08/28/01

**Pl ase find below and/or attached an Office communication concerning this application or  
pr ceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/735,697

Applicant(s)

LEE, NOEL

Examiner

Sharon Polk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 29-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

### **DETAILED ACTION**

1. According to 37 CFR 1.3, Applicants and their attorneys or agents are required to conduct their business with the Patent and Trademark Office with decorum and *courtesy*. (Emphasis added.)

### ***Response to Declarations***

**Note: The Examiner has reconsidered all of the declarations.**

2. The declaration filed on December 12, 2000 under 37 CFR 1.131 has been considered but is ineffective to overcome the 102(b) reference's.

3. Applicant's presumed intent to overcome the Kensington reference, and U.S. Patent 5,589,718, is inapplicable under 37 CFR 1.131, as being a statutory bar.

4. Further, applicant makes unsupported conclusory statements which are not facts. For example, applicant states that the claimed invention was first conceived in May 1993. There is insufficient evidence to support this, such as notes, sketches or drawings dated as such. Conception is the mental part of the inventive act, but it must be capable of proof, as by drawings, complete disclosure to another person, etc. MPEP § 715.07.

Additionally, a conception of an invention, though evidence by disclosure, drawings, and even a model, is not a complete invention under the patent laws, and confers no rights on an inventor, and has no effect on a subsequently granted patent to another, **UNLESS THE INVENTOR FOLLOWS IT WITH REASONABLE DILIGENCE BY SOME OTHER ACT**, such as an actual reduction to practice or filing an application

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for a patent. *Automatic Weighing Mach. Co. v. Pneumatic Scale Corp.*, 166 F.2d 288, 1909 C.D. 498, 139 O.G. 991 (1<sup>st</sup> Cir. 1909).

5. Additionally, applicant, claims common ownership of Exhibit A, which is not the claimed invention, therefore it is not probative.

6. The declarations under 37 CFR 1.132 filed December 12, 2000 is insufficient to overcome the rejection set fourth below.

7. Applicant filed a 42 page 1.132, declaration which included several dozen sheets of Monster cables wholesale of the "alleged" claimed invention to its distributors without any mention of its relevance. There must be a *nexus* between the claimed invention and the sales. The term "nexus" designates a factually and legally sufficient connection between the evidence of commercial success and the claimed invention so that the evidence is of probative value in the determination of nonobviousness. *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 7USPQ2d 1222 (Fed. Cir. 1988).

In considering evidence of commercial success, care should be taken to determine that the commercial success alleged is directly derived from the invention claimed, in a marketplace where the consumer is free to choose on the basis of objective principles, and that such success is not the result of heavy promotion or advertising, shift in advertising, consumption by purchasers normally tied to applicant or assignee, or other business events extraneous to the merits of the claimed invention, etc.

*In re Mageli*, 470, F.2d 1380, 176 USPQ 305 (CCPA 1973).

The Board of Patent Appeals and Interference opined that, merely showing that there was commercial success of an article which embodied the invention is not sufficient. *Ex parte Remark*, 15 USPQ2d 1498, 1502-02 (Bd. Pat. App. & Inter. 1990).

See MPEP § 716.03(b).

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8. Applicant filed two 1.132 declarations, declaring that there was a long felt need for the claimed invention. In order to establish a long felt need, several factors must be considered, first, the defect must have been a recognized and persistent one in fact. *Orthopedic Equip. Co., Inc. v. All Orthopedic Appliances, Inc.*, 707 F.2d 1376, 217 USPQ 1281 (Fed. Cir. 1983); Second, both the length of the perceived need and the failures by others must have been in the context of the "same state of the art." Thus, significant improvements in the art that bear on the inventor's solution dilute the significance of prior need and failures. See *Newell Companies, Inc. v. Kenney Manufacturing Co.*, 864 F.2d 757, 768, 9 USPQ2d 1417, 1426 (Fed. Cir. 1988); Finally, it must appear that the inventor's solution in fact satisfied the long-felt need, that is, reached a result superior to prior solutions.

**Here, applicant had failed to provide adequate support because the declarations are conclusory statements.**

9. Applicant filed a 1.132 declaration intending to show support of secondary considerations, i.e. unique human factor. However, as interpreted the declaration supports the notion of expected beneficial results. "A solid color-coded device having peripheral device identification, constitutes a solid color image which requires far less mental processing than required by the cited art. . ." See Dr. Albert Mehrabian's declaration under 37 C.F.R. 1.132, conclusion, page 6. It appears that through his extensive research, he expects for there to be "*a substantial advantage in using solid colors of high chroma*" (emphasis added) *Id.*, at paragraph 8. The court in *In re Gershon*

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opined that, expected beneficial results are evidence of obviousness just as unexpected results are evidence of unobviousness. In re Gershon, 54 CCPA 1066, 372 F.2d 535, 152 USPQ 602 (1967).

### ***Claim Objections***

10. Claims 37, 39, and 40 objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 37, 39, and 40, as discussed above are not supported by the original specification. As claimed, the kit comprises **claim 29**, plus variations of the other independent claims.

### ***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

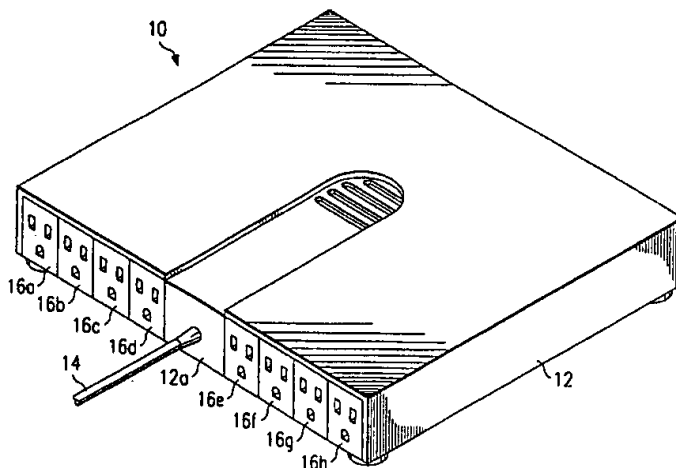
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 29, and 30 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kensington SmartSockets Strip Model and Adapter Model reviewed by LaMont Ridgell of MacUser, published September 1997. The Kensington SmartSocket Strip meets all of the limitations of claims 29, and 30. (See photograph and review).

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13. Claims 29-32 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,589,718 ('718 Pat.).

14. The '718 Pat. teaches all the limitations of claims 29-32. See Figure below. The '718 Pat. teaches an input power cord (14), a plurality of output receptacles (16a-h), and a housing member (12). This reference does not specifically disclose an insulated housing. However, insulation is an inherent property of any electrical device because it serves as protection means. Additionally, the '718 Pat. teaches color-coding system such that the outlets are assigned a different color. (3:35-51, and 4:1-7).



### ***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 33-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,589,718 ('718 Pat.).

17. **Claim 33**— The '718 Pat. teaches an AC, electrical power strip apparatus (10) having a plurality of outlets (16a-16h) comprising an input power cord member (14), an electrical distribution main electrically coupled to said input power cord member and to said plurality of electrical outlets (col. 1, lines 66-67, and col. 2, lines 1-3). '718 Pat. teaches a housing member (12) for housing said distribution mains and said outlets, and for securing said power cord member to said main, said housing have a plurality of discrete areas for receiving a plurality of colored stickers and a plurality of color coded for retrofitting said plurality of outlets, said plurality of colored stickers and said plurality of color coded indicia provided for associating certain ones of said plurality of outlets with a particular color, and for associating certain ones of said plurality of outlets with said plurality of peripheral devices.

*The '718 Pat. does not expressly disclose stickers, however, '718 Pat. discloses:*

[T]he cables that interconnect the above components could have a **red designation** (whether it be by coloring the cables red or **applying a red indicia**, such as stripes or rings on the cables or on the connectors attached to the cables).

('718 Pat., at 3:50-51, and 4:1-3). (emphasis added).

*The '718 Pat. does not expressly claim or disclose a "plurality of colored stickers."* However, well within the scope of the invention is a plurality of color stickers.

[E]ach outlet 16a-16h, and the corresponding portion of the housing containing same would be **color-coded** to correspond to the particular component to be



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powered thereby. In fact, a **color coding scheme** could be imparted to the entire audio-video system including the interconnects that connect the various components.

('718 Pat., at 3:37-43). (emphasis added).

*'718 Pat. does not expressly disclose that a sticker is to be attached to a peripheral device.* However, it can be inferred by use of the phrase entire audio-video system. (*Id.*, at 42). Examiner interprets entire as follows: Entire is defined as having no element or part left out. (Webster's, at 387). Therefore it would be reasonable to infer that the peripheral device would be included as *part* of the entire audio-video system. Alternatively, '718 Pat. discloses:

For example, audio program **sources**, such as CD players, Record players, tape decks and AM/FM tuners would be **assigned a certain color**, such as red[.] (at 3:43-45). (emphasis added).

It is also obvious to infer that a source would not only be assigned a color, but would have indicia indicating that the source was assigned a certain color.

18. **Claim 34** – The '718 Pat., discloses all things previously discussed but also teaches the following limitations: a plurality of sets of a plurality of colored stickers for selective attachment to an interconnecting electrical cord, each colored sticker being distinct, and colored a different color than other color sticker provided on the said portions,

According to another feature of the present invention, an input **designating indicia** is associated with each outlet 16a-16h to **clearly identify** the type of component that should be used with each outlet in accordance with the type of **AC power processing** associated with the outlet.

(*Id.*, at 3:33-37). (emphasis added).

The '718 Pat. does not expressly recite that the colored stickers are distinct from other colored stickers in the set. However '718 Pat., at 4:3-7 discloses;

The video source components, and the outlets 16e and 16f, would be assigned another color and the audio amplifiers, and the outlets 16g and 16h would be assigned still another color.

Therefore, it is clear that they are distinct.

19. **Claim 35** – depends from claim 33, and adds the limitation of colored electrical extension cords, along with the matching color code scheme as previously recited.

The '718 Pat. teaches;

[T]he cables that interconnect the above components could have a red designation (**whether it be by coloring the cables red or applying a red indicia, such as stripes or rings on the cables or on the connectors attached to the cables**).

('718 Pat., at 3:50-51, and 4:1-3). (emphasis added).

Examiner notes that "Cables that interconnect the above components" (*Id.*) is a sufficient description of an extension cord. Further, a plurality of extension cords is consistent with the scope of the invention of '718 Pat., because it is understood that each assigned color portion may need a matching cable that interconnects the above components. As such '718 Pat. teaches this limitation.

20. **Claim 36** – depends from claim 35, and does not add any new limitations not discussed in previous claims.

21. **Claim 37** – '718 Pat., does not expressly disclose a kit having the recited limitations. However, the recitation "A kit" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded

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any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Further, as previously indicated, the kit as recited, is far beyond the scope of the original disclosure.

22. **Claim 38** – is a method claim with follows the apparatus. As such all applicable art rejections based on the apparatus, correspond to this method claim 38.

23. **Claim 39** – recites the limitation “A kit” in the preamble, and that limitation is not given any weight for reasons discussed in claim 37. Claim 39 also recites a new limitation not EXPRESSLY discussed in the above claims. The new limitations are “sets of at least three like-colored stickers” for attaching to a portion, an extension cord, and a peripheral device. Similarly having “all sticker sets” be distinct colors from other sets. The ‘718 Pat. reference inherently teaches these limitations. **These limitations are merely cumulative, changing neither the spirit nor the scope of the invention.**

Further, as previously indicated, the kit as recited, is far beyond the scope of the original disclosure.

24. **Claim 40** – depends form claim 39, and adds the limitations regarding the plurality of extension cords. See above for discussion.

It would have been obvious to one of ordinary skill in the art to modify the device taught by ‘718 Pat., to include stickers to attach to either: discrete areas of the housing extension cords, or peripheral devices or any combination/sub-combination thereof,

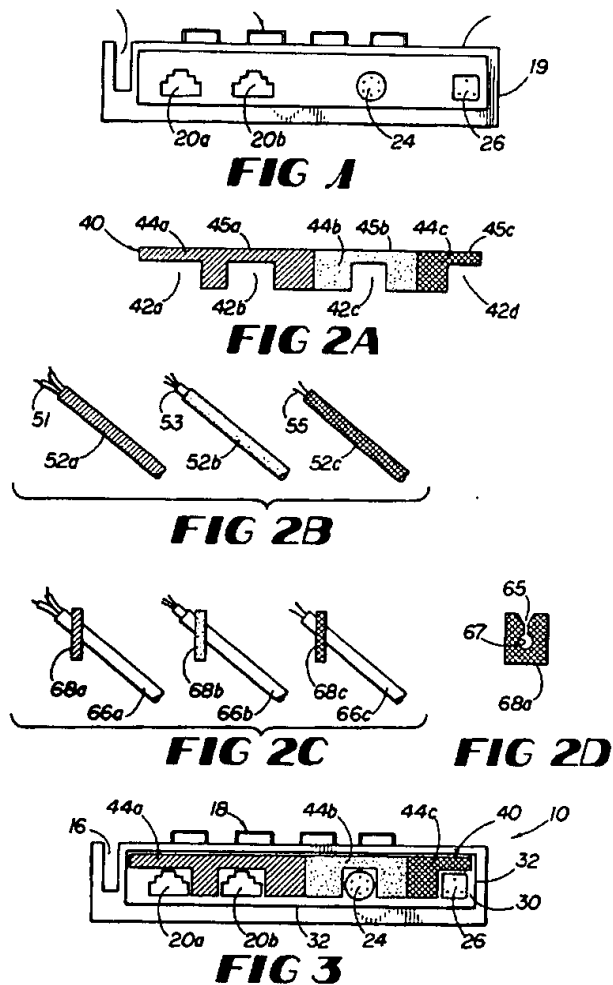
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because consistent with the scope of the '718 Pat. invention, color indicia /(stickers) attached throughout the entire system (powerstrip, extension cord, peripheral device) *enables the various outlets provided to be **easily identified** and thus insures that each component connected thereto will be connected to an outlet specifically designed for the particular electronic characteristic for the component.* ('718 Pat., at 4:14-18). (emphasis added).

25. Claims 33-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5, 589,718 ('718 Pat.) and U.S. Patent 5,775,935, Barna, further in view of U.S. Patent 5,366,250, Sunabe.

The '718 Pat, does not expressly teach stickers or stickers having indicia on them. However, Barna teaches a color coded alignment strip (40), (see figures below) attached to a device, which corresponds to color coded cables (52a, 52b, and 52c). The color coded alignment strip (which extends entirely around the electrical connection ports) is positioned and aligned in a recessed area (30) such that the colors of the alignment strip match the color of the cables.

Barna explicitly teaches the color of the power cord connection cable (52c) corresponds with the color (44c) of the a section of the color coded alignment strip. (5:16-19). Barna also teaches color-coding with tags (68a). Official notice is taken that



the sticker and tag solve the same problem of properly identifying proper connection via a color code system. Hence, both function to ensure easy visual indication.

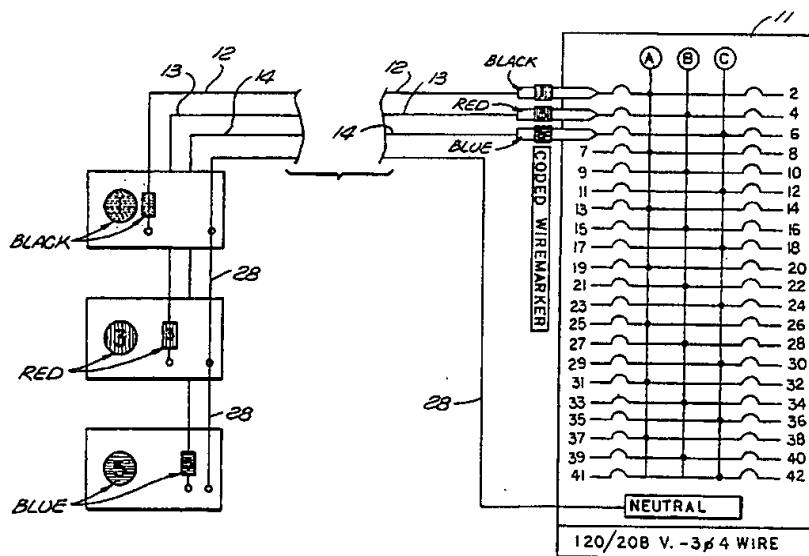
It is obvious to one of ordinary skill in the art at the time of the invention to modify '718 Pat. with the teachings of Barna, because Barna objective was to "provide a cable

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connecting system that secure a color coded alignment strip [ ] in a manner that prevents inadvertent removal of the alignment strip." (Barna, at 3:19-22).

Sunabe teaches a set of wire markers (22), a set of outlet box markers (23) with the markers carried on the carrier with each marker of each set being separable peelable from the carrier. (at 3:50-53). The markers are numbered sequentially and are color coded red, black, and blue. See figure above.

It would have been obvious to one of ordinary skill in the art to modify the teachings of "718 Pat., and Barna, with the teachings of Sunabe because as Sunabe discloses a visual pattern system reduces errors in wiring, and also makes tracing



easier, and provides codes with stand out from conventional wiring diagrams, by "providing two indicia in a single component." (at 3:25-26).

26. Claims 33-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kensington SmartSockets Strip Model and Adapter Model reviewed by LaMont Ridgell of MacUser, (Kensington), published September 1997, in view of U.S. Patent No. 5,366,250, Sunabe.

27. Kensington teaches an electrical power strip apparatus (see figure), comprising a input power cord, an electrical distribution main, a plurality of electrical output receptacles, a housing members to accommodate AC adapters. Included are six pairs of labels that match the colored rings around each socket. Kensington teaches putting on each peripheral and a matching sticker on its power cord.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Kensington with the teachings of Sunabe because both solve the same problem utilizing indicia/indicia means for "end to end" correct attachment of wires to reduce errors or mistakes in connecting or disconnecting of wires.

### ***Response to Arguments***

28. Applicant's arguments filed June 26, 2001 have been fully considered but they are not persuasive.

29. The first commercially viable prototype as admitted by the applicant was manufactured by Monster Cable in September 1997. Which is also the same date as Kensington's September 1997 publication. **The examiner does not know the exact**

**date of either invention.** The applicant asserts that the prototype was *generally in accordance with the proprietary drawing [the drawing] of July 28, 1994*. However, the drawing does not depict any input power cord members, solid color electrical extension cords, solid color stickers, and/or a kit as claimed.

30. In response to applicant's argument regarding examiner's incorrect calculation of reduction to practice/due diligence, the examiner agrees with applicant.

31. In response to applicant's argument regarding hindsight reconstruction, which the examiner strenuously traverses, a distinction was made between permissible hindsight and impermissible hindsight. As long as the judgment takes into account only knowledge which was within the level of ordinary skill at the time of the invention and does not include knowledge gleaned only from applicant's disclosure, "such a reconstruction is proper." *In re McLaughlin*, 443 F.2d at 1395, 170 USPQ at 212 (emphasis added). Essentially hindsight is permissible if the prior art teachings were available independently from applicant's disclosure at the time of applicant's invention. This is precisely on point with regards to applicant's disclosure filed January 1998, and the other references which clearly teach color coding. Admittedly, the reasons for color coding may be different, but the teachings are there nonetheless.

32. In response to applicant's assertion that ***the Examiner has inadvertently allowed the present invention's simplicity to prejudice her examination of the claims under 35 U.S.C. § 103***. The examiner strenuously traverses that statement. The examiner was merely trying to emphasize that color coding is so notorious, and



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further that person's with no skill in the art of power outlets understand the concept of color coding.

33. In response to applicant's assertion that examiner improperly exercised official notice. The examiner traverses that assertion. The MPEP § 2144.03 states:

The rationale supporting an obviousness rejection may be based on common knowledge in the art or "well-known" prior art. The examiner may take official notice of facts outside the record which are capable of instant and unquestionable demonstration as being "well-known" in the art. *In re Ahlert*, 424, F.2d 1088, 1091, 165 USPQ 418, 420, (CCPA 1970).

If justified, the examiner should not be obliged to spend time to product documentary proof. If the knowledge is of such notorious character that official notice can be taken, it is sufficient so to state. *In re Malcolm*, 129 F.2d 529, 54 USPQ 235 (CCPA 1942).

As such the official notice was proper. Further, the examiner never stated that the rejection was based on facts within the personal knowledge of the examiner. Therefore, an affidavit under 37 CFR §1,104(d)(2) is not forthcoming.

34. In response to applicant's arguments regarding improper combination of '718 Patent and the Kensington disclosure. Is applicant stating that both the '718 Patent and Kensington disclosure should *at best* be a nonstatutory double patent rejection as opposed to a 35 USC §103 rejection because they were both commonly owned at the time of the present invention?

### **Conclusion**

35. No claims are allowed.

36. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

37. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharon Polk whose telephone number is 703-308-6257. The examiner can normally be reached on M-F 7-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Josie Ballato can be reached on 703-308-0269. The fax numbers for the organization where this application or proceeding is assigned are 703-308-3914 for regular communications and 703-308-3914 for After Final communications.

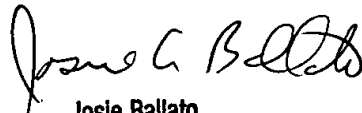
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August 26, 2001

Sharon Polk

Patent Examiner

Art Unit 2836

  
Josie Ballato  
Supervisory Patent Examiner  
Technology Center 2800  
8/27/01